

REMARKS

Claims 1-6 and 16-32 are pending in the present application; upon entry of the Amendments submitted with this Response, Claims 1-6, 16-30 and 32 will remain pending.

Claims 2, 4, 6, 17, 19, 21, 23, 24, and 25 have been amended in response to a Restriction Requirement, without disclaimer of or prejudice to the non-elected subject matter. Moreover, Claims 4, 6, 19, 21, 24, and 26 have been amended to better define certain embodiments of the invention, notwithstanding the Applicants' belief that the unamended claim would have been allowable, and without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute in the future the unamended (or similar) claims in another application, for the purpose of furthering the Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG).¹ None of the amendments to the claims is related to the statutory requirements of patentability unless expressly stated so herein. No amendment made herein was intended to narrow the scope of any of the amended claims.

In particular, 2, 4, 6, 17, 19, 21, 23, 24, and 25 have been amended to elect a species, as required in the Restriction Requirement. Claims 4, 6, 19, 21, 24, and 26 have been amended to clarify that the oil contaminant comprises the elected species.

In the Office Action dated May 6, 2003, the Examiner required the Applicants to elect a single disclosed species from each Genus (Industrial Activities, Oils, and Contaminants) (Office Action, page 4). The Examiner also required a listing of all claims readable upon each elected species.

I. RESTRICTION

Between Species

The Examiner required the Applicants to select a species from one of three groups: Industrial Activity, Oil Species, and Oil Contaminant Species (Office Action, pages 2-4).

II. ELECTION

¹65 Fed. Reg. 54603 (September 8, 2000).

Between Species, without traverse

The Examiner has required a specifically named species in each of the three groups, Industrial Activity, Oil Species, and Oil Contaminant Species

1. Industrial Activity

The Applicant elects the species "parts cleaning and washing" from the group Industrial Activity. Applicants' non-election of the remaining species does not narrow the scope of any of the claims because non-election of these claims is not related to a "statutory requirements for a patent" but rather is related to the Patent Office's administrative convenience for organizing searches. Applicants reserve the right to prosecute the non-elected species in the present or another application(s).

The Applicants note that the Examiner states that upon the allowance of a generic claim, the Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 (Office Action, page 4). Moreover, 37 CFR 1.141(a) states that "more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (Sec. 1.75) or otherwise include all the limitations of the generic claim." Thus, upon allowance of a generic claim, the Applicants **intend to add to the present application** claims to additional species written in dependent form or which otherwise include all the limitations of the allowed generic claim(s), in accordance with 37 CFR 1.141(a).

The Examiner asserted that Claims 1, 16, and 27-30 appear to be generic (Office Action, page 4). Of the species "parts cleaning and washing" from Industrial Activity, Claims 1, 16, and 27-30 read upon that species.

2. Oil Species

The Applicant elects the species "surface finishing oils" from the group Oil Species. Applicants' non-election of the remaining species does not narrow the scope of any of the claims because non-election of these claims is not related to a "statutory requirements for a patent" but rather is related to the Patent Office's administrative convenience for organizing searches.

Applicants reserve the right to prosecute the non-elected Groups and species in another application(s).

Applicants further note that the Claims 4, 6, 19, 21, 24, and 26 have been amended to clarify that the oil **contaminant** comprises the elected species

The Applicants note that the Examiner states that upon the allowance of a generic claim, the Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 (Office Action, page 4). Moreover, 37 CFR 1.141(a) states that “more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (Sec. 1.75) or otherwise include all the limitations of the generic claim.” Thus, upon allowance of a generic claim, the Applicants **intend to add to the present application** claims to additional species written in dependent form or which otherwise include all the limitations of the allowed generic claim(s), in accordance with 37 CFR 1.141(a).

The Examiner asserted that Claims 1, 16, and 27-30 appear to be generic (Office Action, page 4). Of the species “surface finishing oils” from the group Oil Species, Claims 1, 16, and 27-30 read upon that species.

3. Oil Contaminant Species

The Applicants respectfully traverse this requirement for the following reasons. This Restriction is rendered moot, as the Applicants have canceled Claim 31. Therefore, this Restriction Requirement is moot, and the Applicants respectfully request withdrawal of this Requirement for this Genus.

CONCLUSION

The Applicants have elected the species "parts cleaning and washing" from the group Industrial Activity and "surface finishing oils" from the group Oil Species. Thus, it is respectfully submitted that the Applicants' claims should be allowed. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the Dr. Jaen Andrews at (608) 218-6900.

Dated: July 2, 2003

Jaen Andrews

Jaen Andrews
Registration No. 35,051

Please direct all communications to:

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
(608) 218-6900

APPENDIX I

**CLEAN VERSION OF THE ENTIRE SET OF PENDING CLAIMS AS
AMENDED IN THIS COMMUNICATION**

The following is a list of the claims as they would appear following entry of this amendment.

IN THE CLAIMS:

1. (Amended once) A method for removing a layer of an oil contaminant from the surface of an aqueous solution, comprising:
providing
a solution contaminated by oil as a result of an industrial activity, and
a surface skimmer which can be manually controlled from a remote location; and
manually controlling the surface skimmer to remove a layer of oil by the skimmer,
wherein the skimmer operates by means of negative pressure.
2. (Currently amended) A method according to Claim 1, wherein the industrial activity comprises parts cleaning and washing.
3. A method according to Claim 1, where the solution is enclosed in a tank at a location of the industrial activity.
4. (Currently amended) A method according to Claim 1, wherein the oil contaminant comprises surface finishing oils.
5. A method according to Claim 1, further comprising separating the aqueous solution from the oil contaminant removed from the solution surface.

6. (Currently amended) A method according to Claim 1, further comprising separating the aqueous solution from the oil contaminant removed from the solution surface, wherein the industrial activity comprises parts cleaning and washing, and wherein the oil contaminant comprises surface finishing oils.

7-15 (Canceled)

16. (Previously added) A method for removing a layer of an oil contaminant from the surface of an aqueous solution, comprising:

providing

a solution contaminated by oil as a result of an industrial activity, and

a surface skimmer which does not utilize water ballasts and which can be manually controlled from a remote location; and

manually controlling the surface skimmer to remove a layer of oil by the skimmer.

17. (Previously added; currently amended) A method according to Claim 16, wherein the industrial activity parts cleaning and washing.

18. (Previously added) A method according to Claim 16, where the solution is enclosed in a tank at a location of the industrial activity.

19. (Previously added; currently amended) A method according to Claim 16, wherein the oil contaminant comprises surface finishing oils.

20. (Previously added) A method according to Claim 16, further comprising separating the aqueous solution from the oil contaminant removed from the solution surface.

21. (Previously added; currently amended) A method according to Claim 16, further comprising separating the aqueous solution from the oil contaminant removed from the solution surface, wherein the industrial activity comprises parts cleaning and washing, wherein the

solution is enclosed in a tank at a location of the industrial activity, and wherein the oil contaminant comprises surface finishing oils.

22. (Previously added) A method according to Claim 1, wherein the skimmer does not utilize water ballasts.

23. (Previously added; currently amended) A method according to Claim 22, wherein the industrial activity comprises parts cleaning and washing.

24. (Previously added; currently amended) A method according to Claim 22, wherein the oil contaminant comprises surface finishing oils.

25. (Previously added) A method according to Claim 22, further comprising separating the aqueous solution from the oil contaminant removed from the solution surface.

26. (Previously added; currently amended) A method according to Claim 22, further comprising separating the aqueous solution from the oil contaminant removed from the solution surface, wherein the industrial activity comprises parts cleaning and washing, wherein the solution is enclosed in a tank at a location of the industrial activity, and wherein the oil contaminant comprises surface finishing oils.

27. (Previously added) A method for removing a layer of an oil contaminant from the surface of an aqueous solution, comprising:

providing

a solution contaminated by oil as a result of an industrial activity, and

a surface skimmer which can be manually controlled from a remote location, and

manually controlling the surface skimmer to remove a layer of oil by the skimmer,

wherein the skimmer comprises a hollow tube with two ends and two openings,

wherein a first opening is a skimmer inlet, where the inlet is an opening cut horizontally along the tube, and close to a first end which is closed,

and wherein a second opening is a skimmer outlet, and is a second end which is open and which can be connected to the conduit.

28. (Previously added) The method of Claim 27, wherein the skimmer operates by means of negative pressure.

29. (Previously added) A method for removing a layer of an oil contaminant from the surface of an aqueous solution, comprising:

providing

a solution contaminated by oil as a result of an industrial activity, and

a surface skimmer which can be manually controlled from a remote location, and manually controlling the surface skimmer to remove a layer of oil by the skimmer, wherein the skimmer comprises

a hollow tube with two ends and two openings,

where a first end of the tube is partially closed and comprises an inlet, where the inlet extends along the tube from the partially closed first end,

and where a second end of the tube is open and comprises an outlet,

and further where the tube is angled between the first and the second end.

30. (Previously added) The method of Claim 29, wherein the skimmer operates by means of negative pressure.

31. (Previously added; Canceled)

32. (Previously added) A method for removing a layer of an oil contaminant from the surface of an aqueous solution, comprising:

providing

a solution contaminated by oil as a result of an industrial activity, and

a surface skimmer which can be manually controlled from a remote location; and manually controlling the surface skimmer to remove a layer of oil by the skimmer,

wherein a source oil of the oil contaminant is a mixture of at least one oil and at least one additive and is manufactured or blended for an industrial activity.